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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,630

Applicant(s)

CHUNG ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 45-68 is/are pending in the application.
- 4a) Of the above claim(s) 52 and 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-51, 53-60 and 62-68 is/are rejected.
- 7) ☒ Claim(s) 65-68 (formerly 66-69) is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20050322
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

RD

## DETAILED ACTION

### *Specification*

1. The objection to the abstract has been withdrawn by the Examiner.

### *Claim Objections*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 66-69 have been renumbered 65-68.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 51 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner finds no support in the original specification for the claim limitation *the file being prepared by and stored on the reproduction apparatus prior to transmission to the server* as amended on March 23, 2005.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 45-64 and 65-67 [formerly claims 66-68] are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The term "additional information" in claims 45-64 is a relative term which renders the claim indefinite. The term "additional information" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what "additional information" comprises, nor is it clear what the "additional information" is in addition to. For purposes of compact prosecution, Examiner will treat this as "information."

8. In regard to claims 65-67, the indefiniteness problems associated with claim 45 cause additional problems with these claims. Since the Examiner cannot ascertain what additional information entails and what the contents entail, the Examiner cannot tell what is being reproduced in claims 65-67 and what is not being reproduced in claims 65-67. Claim 67 is written so that the Examiner cannot ascertain what the input request limitations are – whether it is requesting receipt of additional information or whether it is requesting receipt of additional information during a copying function. The Examiner is interpreting claims 66-68 as best possible for purposes of compact prosecution as reproducing the additional information.

***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 51 and 53-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Levy et al. (U.S. Patent No. 6,505,160).

11. In regard to claim 51, Levy discloses an additional information database which stores additional information items with respect to a plurality of contents; and a server for receiving a file including an identifier of predetermined contents from a reproduction apparatus for reproducing the contents, the file being prepared by and stored on the reproduction apparatus prior to transmission to the server, retrieving one of the additional information items corresponding to the contents identifier from the additional

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information data base, and transmitting the retrieved one additional information item to the reproduction apparatus, wherein the contents identifier is recorded in at least one recording medium on which the contents are recorded. Levy discloses a database that can be searched for related data to an identifier.

[column 4, lines 56-63] Levy discloses the database is on a server. The server receives the identifier, searches that database using the identifier, and transmits the retrieved data to the reproduction apparatus. [column 4, lines 40-65] The identifier is stored in a file on the reproduction apparatus before transmission to the server [column 3, lines 50-64, column 4, lines 40-45] and the contents identifier is recorded in at least one recording medium on which the contents are recorded. [column 3, lines 50-64]

12. In regard to claim 53, Levy is applied as in claim 51. Levy further discloses *an international standard recording code (ISRC) is recorded in at least one recording medium on which the contents are recorded, and the server receives the ISRC code as the contents identifier, retrieves the one of <sup>the</sup> ~~the~~ additional information items mapped to the ISRC code from the additional information database, and transmits the retrieved one additional information item to the reproduction apparatus.* Levy further discloses the use of an ISRC code as an identifier. [column 3, lines 28-29]

13. In regard to claim 54, Levy is applied as in claim 51. Levy further discloses *the server transmits the additional information item corresponding to the received contents identifier to the reproduction apparatus* [column 4, lines 62-63], *and the reproduction apparatus comprises: an identifier provider for providing the identifier of the contents* [Levy discloses a decoding device which extracts an identifier from an object. See Levy, column 2, lines 46-48.], *a network controller* [Levy discloses accessing a computer network to get the information with a communication application. See Levy, column 4, lines 40-43.], *and a controller for receiving the contents identifier from the identifier provider, transmitting the provided contents identifier to the server through the network connector, receiving the additional information item provided from the server through the network connector corresponding to the transmitted contents identifier, and displaying the received additional information item* [Levy's communication apparatus sends information to a server, which looks up the identifier in a local database and returns that information to the user's computer. See Levy, column 4, lines 40-63. Data is returned to the communication apparatus.

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See Levy, column 5, lines 51-53. The additional information can be displayed. See Levy, column 15, lines 10-14].

14. In regard to claim 55, Levy is applied as in claim 51. Levy further discloses *the reproduction apparatus further comprises a reading unit for reading data from at least one storage medium* [Levy discloses extracting the identifier from a recording medium. See Levy, column 2, lines 29-37. Extracting the identifier would involve reading the data.], *the at least one storage medium stores the contents* [In order to read data contents from the storage medium, they must be stored on the medium.], *the identifier provider provides the contents identifier read from the at least one storage medium to the controller* [See Levy, column 2, lines 29-37.], *and the controller receives the contents identifier from the reproduction apparatus for transmitting the contents identifier provided by the identifier provider through the network connector to the server* [See Levy, column 4, lines 40-45.].

15. In regard to claim 56, Levy is applied as in claim 55. Levy further discloses *the server receives an international standard recording code (ISRC) read from the at least one storage medium by the reading unit and provides the received ISRC code as the contents identifier to the controller.* [Levy discloses the use of an ISRC code as an identifier. See Levy, column 3, lines 28-29.]

16. In regard to claim 57, Levy is applied as in claim 51. Levy further discloses *the server receives the contents identifier from a browser installed in a controller of the reproduction apparatus.* [Levy discloses implementing the communication apparatus as a web browser. See Levy, column 5, lines 54-56.]

#### **Claim Rejections - 35 USC § 103**

17. Claims 45-50 and 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al. (U.S. Patent No. 6,505,160) and Leonhard et al. (U.S. Pub. No. 2002/0052933).

18. In regard to claim 45, Levy discloses *an identifier provider for providing an identifier of the contents* [Levy discloses a decoding device which extracts an identifier from an object. See Levy, column 2, lines 46-48.]; *a network controller* [Levy discloses accessing a computer network to get the information with a communication application. See Levy, column 4, lines 40-43.]; *and a controller for transmitting the*

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*contents identifier provided by the identifier provider to a server system, which provides additional information corresponding to the contents through the network connector, and receiving the additional information provided from the server system through the network connector* [Levy's communication apparatus sends information to a server, which looks up the identifier in a local database and returns that information to the user's computer. See Levy, column 4, lines 40-63.]. Levy fails to disclose use of a Cookie file to transmit the identifier provider.

19. However, Leonhard discloses transmitting information by way of a cookie. [Leonhard checks a cookie to determine information for a user. See Leonhard, page 19, paragraph 0416. See Leonhard, page 19, paragraph 0418.]

20. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Levy and Leonhard for the purpose of using a cookie to get media information with ease over a network. [See Leonhard, page 3, paragraph 0045.] Levy gives motivation for the combination by stating that communicating with the communication application can be established by use of a web browser. [See Levy, column 5, lines 51-59.] It is well established in the art that a cookie is commonly utilized in association with a web browser.

21. In regard to claim 46, Levy in view of Leonhard is applied as in claim 45. Levy further discloses a *reading unit for reading data from at least one storage medium, in which the contents are stored, and reads the contents identifier from the at least one storage medium, wherein the identifier provider provides the read contents identifier read from the at least one storage medium to the controller* [Levy discloses reading data and an identifier from a storage medium such as a DVD or CD. The decoder then extracts the identifier. See Levy, column 2, lines 29-48.]

22. In regard to claim 47, Levy in view of Leonhard is applied as in claim 45. Levy further discloses a *reading unit for reading data from at least one storage medium in which the contents are stored* [Levy discloses reading data from a storage medium. See Levy, column 2, lines 29-37.], *and reads an international standard recording code (ISRC) from the at least one storage medium, wherein the identifier provider receives the ISRC read and provides the ISRC as the contents identifier to the controller* [Levy discloses the identifier can be an ISRC code. See Levy, column 3, lines 24-29.].

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23. In regard to claim 48, Levy in view of Leonhard is applied as in claim 45. Levy further discloses a *reading unit for reading the contents from at least one storage medium in which the contents are stored* [See Levy, column 2, lines 29-37.], and a *reproducer for reproducing contents read by the reading unit* [Levy discloses using a decoder with a media player. Playing media is synonymous with reproducing contents read by the reading unit. See Levy, column 12, lines 16-21].

24. In regard to claim 49, Levy in view of Leonhard is applied as in claim 48. Levy further discloses a *decoder for decoding the read contents* [See Levy, column 12, lines 11-21].

25. In regard to claim 50, Levy in view of Leonhard is applied as in claim 49. Levy further discloses a *speaker for receiving audio data output from the decoder and delivering sound; and a display apparatus for receiving video data output from the decoder and displaying images* [Levy discloses using a media player for the data being read, such as Windows Media Player or Real Player. See Levy, column 12, lines 11-21. It is well known in the art that media players take advantage of a computer's display and speakers to play video and audio. Levy further discloses audio devices for playback. See Levy, column 13, lines 25-28. Levy further discloses a video display apparatus. See Levy, column 13, lines 41-45.].

26. In regard to claim 58, Levy is applied as in claim 57. Levy fails to disclose the use of a Cookie file to transmit information.

27. However, Leonhard discloses transmitting information by way of a cookie. [Leonhard checks a cookie to determine information for a user. See Leonhard, page 19, paragraph 0416. See Leonhard, page 19, paragraph 0418.]

28. The motivation for the combination of these teachings is the same motivation applied to claim 45.

29. In regard to claim 59, the limitations of this claim are substantially the same as the limitations of claim 45. Therefore the rationale used to reject claim 45 is used to reject claim 59. Levy further discloses the use of an ISRC code as an identifier. See Levy, column 3, lines 28-29.

30. In regard to claim 60, Levy in view of Leonhard is applied as in claim 59. Levy further discloses reading data from a storage medium. See Levy, column 2, lines 29-37.

31. In regard to claim 62, Levy in view of Leonhard is applied as in claim 60. Leonhard has already disclosed the use of a Cookie to transmit information [See claim 45] and Levy has already disclosed



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reading an identifier from the medium and transmitting it to the server [See claim 46. See claim 54.] The motivation for using a cookie to transmit the identifier has been established previously. [See claim 60. See claims 45 and 47.] Preparing and storing the cookie by the apparatus are necessary and obvious steps that precede transmitting the cookie. If the cookie were not prepared and stored, then it could not be transmitted. Examiner considers placing the cookie in memory in preparation for transmission to be storing the cookie.

32. In regard to claim 63, Levy in view of Leonhard is applied as in claim 60. Leonhard has already disclosed the use of a Cookie to transmit information [See claim 45] and Levy has already disclosed reading an identifier from the medium and transmitting it to the server [See claim 46. See claim 54.] The motivation for using a cookie to transmit the identifier has been established previously. [See claim 60. See claims 45 and 47.] Preparing and storing the cookie by the apparatus are necessary and obvious steps that precede transmitting the cookie. If the cookie were not prepared and stored, then it could not be transmitted. Examiner considers placing the cookie in memory in preparation for transmission to be storing the cookie. The use of a web browser as part of the communication apparatus has already been established. [See motivation for claim 45.]

33. In regard to claim 64, Levy in view of Leonhard is applied as in claim 60. Leonhard has already disclosed the use of a Cookie to transmit information [See claim 45] and Levy has already disclosed reading an identifier from the medium and transmitting it to the server [See claim 46. See claim 54.] The motivation for using a cookie to transmit the identifier has been established previously. [See claim 60. See claims 45 and 47.] Preparing and storing the cookie by the apparatus are necessary and obvious steps that precede transmitting the cookie. If the cookie were not prepared and stored, then it could not be transmitted. Examiner considers placing the cookie in memory in preparation for transmission to be storing the cookie. The use of a web browser as part of the communication apparatus has already been established. [See motivation for claim 45.]

34. In regard to claim 65 as best understood by the Examiner, Levy in view of Leonhard is applied as in claim 45. Levy further discloses reproducing the additional information without reproducing the

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corresponding contents. Levy returns data associated with the identifier. See Levy, column 4, lines 62-65.

35. In regard to claim 66 as best understood by the Examiner, Levy in view of Leonhard is applied as in claim 45. Levy further discloses reproducing the additional information while reproducing the corresponding contents. See Levy, column 4, lines 40-45, column 4, lines 62-65.

36. In regard to claim 67 as best understood by the Examiner, Levy in view of Leonhard is applied as in claim 45. Levy further discloses reproducing the additional information without reproducing the corresponding contents. Levy further discloses reproducing the additional information while reproducing the corresponding contents. See Levy, column 4, lines 40-45, column 4, lines 62-65. Levy also allows the user to make decisions on how the information is downloaded [an input]. See Levy, column 5, lines 1-11. It would be obvious to one of ordinary skill in the art that a user could configure a device to copy information in many different ways and that a user could configure a device to copy some information and choose whether or not to copy other information, based upon file copying skills well known in the art.

37. In regard to claim 68, Levy in view of Leonhard is applied as in claim 45. The use of a memory to store a file before transmission over a network is inherent to the Levy and Leonard combination, both separately and as a combination.

### ***Response to Arguments***

38. Applicant's arguments filed 3/23/2005 have been fully considered but they are not persuasive.

39. Applicant argues that the rejection under 35 U.S.C. 112 is improper because one of ordinary skill in the art would be able to ascertain what Applicant defines by the term *additional information* based on paragraph 0004 of the disclosure. Paragraph 0004 states "There are various additional information related to the audio contents or the video contents. For example, in the case of music videos, additional information could include the words of the songs, personal information items on the singers, contents of recent activities, and other hit songs of a similar genre. However, when a user desires to know such additional information, the user must access other media." The Examiner does not find this paragraph,

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nor the rest of the disclosure, adequate in defining what Applicant is attempting to encompass by using the claim limitation *additional information*. The Examiner further finds no explanation of what is encompassed by the *contents* being reproduced in order to specify to one of ordinary skill in the art what *additional information* could be retrieved to be used in conjunction with the unclear *contents* described in the preamble. Applicant is requested to clearly define what information is being retrieved and what the information is being used in conjunction with, as the Examiner is unclear what Applicant is seeking to claim at this point in time, partially because Applicant has used vague and nebulous terms such as *contents* and *additional information*.

40. Applicant argues that there is no suggestion in Levy that an ID is stored in a decoder using a file or other device, and that the stored ID is what is received by the server. In order to transmit the ID to the server, it would be inherent to store it in the decoder in a file. Levy teaches that the ID is received by the server. See Levy, column 4, lines 40-43.

41. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a cookie is well known as a technique for assisting in web browsing. Leonhard teaches use of a cookie. Levy uses a web browser to retrieve information. If Levy uses a web browser, and a cookie is commonly used in web browsers, and Leonhard teaches the use of cookies, then the use of Leonhard with Levy is obvious.

42. Applicant argues that Levy does not suggest a need for storing the contents ID since the contents ID is already contained on the storage medium. If the contents ID is on a storage medium, then it needs to be stored there at some point. Additionally, any transmission through a network would require temporary storage at a hop or network device at some point in order for the transmission to occur without great packet and signal loss through attenuation over long distances.

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43. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

44. The above are rebuttals to the complete substance of Applicant's lengthy arguments.

### **Conclusion**

45. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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JMS

  
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